

Application No.: 10/658,337
Amendment dated April 21, 2005
Reply to Office Action of October 21, 2004

Amendments to the Drawings

Please replace drawing Figure 3 with the attached proposed amended informal Figure 3. A formal version of Figure 3 will be submitted promptly via a Supplemental Response.

Remarks

The Applicant respectfully requests entry of the above Amendments, and consideration of the application as amended.

By these amendments, the Applicant addressed objections to the specification and drawings and introduced new claims 18 through 35. No new matter was introduced.

New claims 18 through 28 recite the "non-toxic fishing sinker" aspect of the present invention. Support for this aspect of the invention may be found throughout the specification. Specifically, in numerous locations in the specification, for example, in lines 1-5 on page 4 and in lines 3-5 on page 7, reference is made to the aspects of the invention "acting like a lead sinker" or "replacing lead sinkers."

New claims 29 through 35 are dependent upon claim 1.

Claims 2-11, and claims 14 and 15 were previously cancelled. Claims 1, 12, 13, and 16-35 are now pending in this application.

The Applicant advises the Patent Office that a Supplementary Information Disclosure Statement and Citation are being filed with this Response. This Citation identifies an excerpt from a fishing lure catalog that inspired the Applicant to conceive of aspects of the present invention. This Citation is being submitted to comply with the Applicant's duty of candor.

1. General Comments

The Applicant believes that the following comments will be helpful in understanding aspects of the present invention and distinguishing aspects of the invention from the prior art.

In conceiving and developing aspects of the invention, the Applicant desired to provide a fishing sinker that could be used to replace the conventional lead "split shot" sinkers that have been used by anglers for years. As is well known in the art, the lead content of the sinkers has been known to be hazardous to fish and water fowl (and to the fisherman) and as a result lead shot or other lead-containing sinkers have been generally limited or banned in many jurisdictions. For example, in New York, the Applicant's state of residence, recent laws have limited the size of lead-containing sinkers that can be used. In Canada, the use of lead sinkers of any size has been banned.

The need to find a suitable replacement for lead-containing sinkers motivated the Applicant to fabricate various lead-less sinkers from miscellaneous hardware, including tin cans and plastic parts. None of these initial attempts provided a suitable non-lead sinker.

The Applicant then located a non-sinker device in a fishing lure catalog and modified it to provide the long-sought-after non-lead sinker. Specifically, the Applicant located the "metal plug bills" in a Stamina lure hardware catalog [herein "the catalog"]; an excerpt of one such catalog was submitted herewith in the attached Invention Disclosure Citation (IDC). Though the Stamina catalog submitted in the attached IDC (dated "Summer 2004") was published after the filing date of this application, page 46 of this except illustrates a typical "Style 1 metal plug bill" which inspired the Applicant to conceive of and develop aspects of the present invention before the filing date of this application. However, the Applicant utilized the device shown in the Stamina catalog in a novel and non-obvious fashion, unrelated to the function and use of the plug bill disclosed in the catalog and known to those skilled in the art. The distinctions between function and use of aspects of the present invention and the function and use of the plug bills of the Stamina catalog are illustrated in attached Figures A and B.

Figure A illustrates the conventional use of the metal plug bill illustrated on page 46 of the Stamina catalog. As shown, plug bills are typically mounted to a wooden body, for example, one of the "basswood bodies" shown on page 45 of the Stamina catalog, to provide the foundation for a light weight, typically floatable lure. As shown in Figure A, the plug bill is mounted to the wooden body by means of screws that engage two through holes in the plug bill. In addition, the "spurs" of the plug bills are included conventionally to provide lateral stability to the mounting of the plug bill to the wooden body, otherwise, an unsupported plug bill may gradually disengage the screws that fasten the plug bill to the wooden body. The strap in the lip of the plug bill provides a location for attaching a fishing line. Clearly, the conventional use of such a plug bill does not provide the sinker or lip jig rig function of aspects of the present invention.

Attached Figure B illustrates an aspect of the present invention employing a plug bill illustrated in the Stamina catalog. However, contrary to the conventional use of such a plug bill, this aspect of the invention (similar to what is shown in Figures 2-4 of the present application) provides a non-lead device having sufficient weight to act as sinker while having an angled lip which promotes sinking and wobbling of the sinker when exposed to a flow of liquid, for example, due to a reeling in, due to a current or due to trolling. In addition, as shown in Figure B, the mounting holes that conventionally are used to mount the plug bill to a lure body, according to aspects of the invention, provide holes for mounting fishing line, hooks, or related lure hardware. Moreover, the support "spurs" of the plug bill provide a means for mounting bait or other structures to the sinker or lip jig rig.

Accordingly, the Applicant has provided a lip jig rig and sinker by modifying a known device heretofore not known to provide the function of a lip jig rig or sinker. The Applicant submits that this use of an existing non-lead plug bill to provide a replacement for lead-containing sinkers and lip jig rigs is both novel and non-obvious in view of the plug bill shown in the Stamina catalog and the prior art of record (and, the Applicant reports, provides an effective means of catching fish).

2. Response to Objection to the Drawings

In paragraph 3 on page 3 of the Office Action, the Patent Office objected to Figure 3. The Applicant believes that the proposed drawing corrections shown in the attached informal marked-up copy of Figure 3 address this objection. The Applicant is presently preparing a formal drawing for Figure 3 and will submit it in a supplemental response filed shortly.

3. Response to Objection to the Specification

In paragraph 4 on page 3 of the Office Action, the Patent Office objected to the wording of the passage on line 9 of page 7. The Applicant believes that the above amendment to the Specification addresses this objection.

4. Response to Rejections Pursuant to 35 USC §102 based upon Ehlers

In paragraphs 5 and 6 on pages 3 and 4 of the Office Action, the Patent Office rejected claims 1 and 16 pursuant to 35 U.S.C. 102(b) as anticipated by U.S. Patent 4,898,431 of Ehlers [herein "Ehlers"]. However, the Applicant respectfully submits that this rejection is inappropriate and respectfully requests that the Patent Office reconsider this rejection in view of the following observations and comments.

First, the Applicant acknowledges with appreciation the Patent Office's leniency when interpreting the inconsistencies of the amendment filed by others on August 16, 2004. Though the amendment canceled claims 1-17 and then miss-identified amended claim 1 as "Claim 18 (New)," the Patent Office was savvy enough to recognize the error and understanding enough to treat claim 18 as amended claim 1. (The Applicant has no record of any communication with the prior representative that may have addressed these inconsistencies.) Thank you.

The Applicant's undersigned Agent often refers to the MPEP for assistance when considering whether an anticipation rejection is appropriate. Specifically, MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim... [Emphasis added.]

With respect to the rejection of claim 1, the Applicant submits that Ehlers does not set forth each and every element set forth in claim 1 and does not disclose the identical invention shown in as complete detail as recited in claim 1. Thus, the Applicant submits that Ehlers does not anticipate the invention of claim 1.

Specifically, the Patent Office identifies the lip 14 of Ehlers having the claimed "front portion" 18 and a "rear portion" 16. The Patent Office then identifies apertures 22, 24 of Ehlers as the claimed "first aperture" and the aperture "through which [rivet] 58 extends" as the claimed "second aperture." However, according to the invention recited in claim 1, the first aperture is "on the front portion" and the second aperture is "on the back portion." The Applicant respectfully submits that this is not what is disclosed by Ehlers. The rear portion 16 of Ehlers includes no perforations. Though the Patent Office appears to interpret "reach 46" as the back portion of the lip having an aperture for rivet 58, close examination of Ehlers indicates that reach 46 is not part of the lip and thus cannot be interpreted as the back portion of the lip as claimed. Specifically, as recited in 3:5-6 of Ehlers states, "Lip 14 is comprised of a first planar section 16 and a second planar section 18." Also, at 3:36-37, Ehlers states, "A single piece frame

member is shown comprising lip 14 and reach 46.” Clearly, reach 46 having a hole through which rivet 58 passes is not part of the lip. Therefore, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

In addition, the Applicant respectfully submits that the “rib 26” of Ehlers is not a “punched out strap” as claimed. As recited at 3:11-15 Ehlers states:

Referring to FIG. 2, lip 14 has two openings 22 and 24 formed in it. Opening 22 and 24 are position adjacent to each other such that a rib 26 is formed therebetween. Openings 22 and 24 and rib 26 comprise an attachment point 28 formed in link 14. [Emphasis added.]

The Applicant respectfully submits that rib 26 is clearly not a “punched out strap” as claimed and clearly shown and discussed in the instant specification. There is no discussion or suggestion in Ehlers that rib 26 is “punched out” in any way. As noted above, it is “openings 22 and 24 [which are] formed in [lip 14].” The only interpretation that can be made by one skilled in the art is that rib 26 is created when openings 22 and 24 are formed. Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

Moreover, the Applicant respectfully submits that Ehlers does not disclose the mounting of the hook as recited in claim 1. Specifically, claim 1 recites that the hook is attached “to the lip at an area between the first aperture and the second aperture.” As shown in Figure 3 of Ehlers and described at 3:45-48, hook member 50 of Ehlers is attached to reach 46 of Ehlers. As discussed above, reach 46 of Ehlers does not comprise the lip 14 of Ehlers but is distinct from the lip 14. Thus, the hook 50 of Ehlers is not attached to the lip of Ehlers as claimed. In addition, the hook 50 of Ehlers is not attached “between the first aperture and the second aperture” as claimed. The only

apertures in the lip of Ehlers are the openings 22 and 24 (again the hole of rivet 58 is not in the lip but in the reach of Ehlers), and the hook of Ehlers is not attached anywhere near openings 22 and 24, and clearly not between them. Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

Further still, the Applicant respectfully submits that the hook of Ehlers is not attached to the lip of Ehlers by "molded material encasing the end of the hook" as claimed. The Patent Office identifies body 12 of Ehlers as the molded material encasing and attaching the hook to the lip. However, the Applicant submits that close examination of Ehlers indicates that body 12 is somehow mounted to the frame of Ehlers but there is not disclosure or suggestion that body 12 in anyway attaches the hook 50 to the lip 14. (As discussed above, hook 50 is mounted to reach 46, not to lip 14.) Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

Even further, the Applicant respectfully submits that Ehlers does not disclose "a plurality of spurs on the area provided between the back portion and the front portion of the lip" as claimed. In the Office Action, the Patent Office identifies the barbs 40 and 42 of hook 50 of Ehlers as the claimed spurs. However, in the claimed invention, the spurs are provided "between the back portion and the front portion of the lip." The Applicant respectfully submits that the barbs 40 and 42 of Ehlers are not positioned anywhere near the lip, and are clearly not located "between the back portion and the front portion of the lip" as claimed. Again, since Ehlers does not set forth each and every element set forth in claim 1, the Applicant submits that claim 1 is not anticipated by Ehlers and requests that this rejection be reconsidered and withdrawn.

The Applicant submits that any one of these distinctions is sufficient to overcome an anticipation rejection of claim 1 based upon Ehlers. However, the existence of at least these five (5) distinctions underscores how markedly different the device of Ehlers is from the invention recited in claim 1.

With respect to the rejection of claim 16 as anticipated by Ehlers, the Applicant submits that claim 16 is not anticipated by Ehlers for the same reasons claim 1 is not anticipated by Ehlers. The Applicant respectfully requests that this rejection also be reconsidered and withdrawn.

5. Response to Rejections Pursuant to 35 USC §103 based upon Ehlers

In paragraphs 7 and 8 on pages 4 and 5 of the Office Action, the Patent Office rejected claims 16 and 17 pursuant to 35 U.S.C. 103(a) as obvious in view of Ehlers. However, the Applicant respectfully submits that these rejections are inappropriate and respectfully requests that the Patent Office reconsider these rejections in view of the following comments. The Applicant submits that claims 16 and 17 are allowable for the same reasons that claim 1 is allowable, as discussed above. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

6. The distinctions of Claims 18 and its dependents from the art of record

As discussed above, claim 18 and its dependents recite the "non-lead fishing sinker" aspect of the invention. The Applicant submits that none of the art of record in any way anticipates the invention recited in claim 18. All of the art of record discloses some form of lures; none of the art discloses sinkers or any devices related to sinkers. The Applicant submits that the invention of claim 18 and its dependents is also non-obvious in view of the art of record.

7. Conclusions

The Applicant submits that, based upon the above observations and arguments, :

1) The inventions of claims 1 and 16 are not anticipated by Ehlers (See Section 4 above.);

2) The inventions of claims 16 and 17 are not obvious in view of Ehlers (See Section 5 above.); and

3) The inventions of claims 18 and its dependents are not anticipated and are not obvious in view of any of the art of record (See Section 4 above.).

The Applicant believes that the application is in allowable form. Early passage of the application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action.

Respectfully submitted,



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